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FEB 25 1943

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1942.

No. 763

DIXIE ROSE NURSERY, *Petitioner*,

v.

CONWAY P. COE, Commissioner of Patents, *Respondent*.

**PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, BRIEF IN SUPPORT THEREOF, AND MOTION TO PROCEED ON CERTIFIED TRANSCRIPT OF RECORD AND ORIGINAL EXHIBITS.**

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
*Attorneys for Petitioner.*

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CONTENTS.


Page

Motion to Proceed on Certified Transcript of Record and Original Exhibits ..... 1-2

Petition for Writ of Certiorari ..... 3-18

Summary of Matter Involved ..... 4-5

The Facts ..... 5-7

The Trial Below ..... 7-8

The Decisions Below ..... 8-11

Statement of Jurisdiction ..... 11

The Questions Presented ..... 11-14

Statute Involved ..... 14-15

Reasons Relied on for the Allowance of the Writ... 15-18

Certification of Counsel ..... 18

Brief in Support of Petition ..... 19-38

Jurisdiction ..... 19

Statement of the Case ..... 19

Summary of Argument ..... 19-20

Point I—The limitation contained in Section 5 of the Trade-Mark Act of 1905, prohibiting registration of *merely* descriptive or *merely* geographical marks, was solely intended to deny registration to those marks which are descriptive or geographical *as a whole* ..... 21-23

Point II—Descriptiveness or geographical significance of a trade-mark may not properly be presumed or implied in the absence of strict and positive proof of such descriptiveness or geographical significance ..... 24-26

Point III—The monopoly afforded by registration of a trade-mark is wholly separate and distinctively different from the monopoly afforded by a patent, 27-28

Page

Point IV—The history of the trade-mark practice before the Patent Office and as interpreted by this Court and other courts of the land, does not deny the right of registration to variety trade-marks for varieties of goods including varieties of plants....28-32

Point V—The rule in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186, and Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc. (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575 does not apply to the facts and evidence in the case here before the Court .....32-33

Point VI—Disclaimer of descriptive or geographical features of composite trade-marks is not a prerequisite to registration under the Trade-Mark Act of 1905, when the trade-mark as a whole is not merely descriptive or merely geographical .....34-35

Point VII—Adoption by a trial court of findings prepared and submitted by the winning party to the suit, as in this case, is not a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in the absence of a written or oral opinion or expression of views of the court as to the sufficency of the trial evidence to support the judgment of the court .....35-37

Point VIII—This case is one of first impression....37-38

Conclusion ..... 38

## TABLE OF CASES CITED.

Baldwin Company v. Robertson, 265 U. S. 168, 179 .... 24
Batcheller v. Thompson (C. C. A. 2), 93 Fed. 660 ....16, 27
Discussion by Judge Gunnar H. Nordbye, 1 F. R. D. 27, 29 ..... 36
Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc. (C. C. A. 2), 85 F (2d) 75, 80, cert. den. 304 U. S. 575 .....5, 9, 10, 16, 20, 32
Estate of P. D. Beckwith v. Commissioner of Patents, 252 U. S. 538 .....13, 16, 22, 34
Ex Parte Eastman Kodak Co., 55 U. S. P. Q. 361..... 29
Ex Parte W. F. Hebard & Co., 56 U. S. P. Q. 114 ..... 29

Page

Ex Parte Pfister Hybrid Corn Co., 56 U. S. P. Q. 275.. 31
Hamilton-Brown Shoe Co. v. Wolf Bros., & Co., 240 U. S. 251 .....5, 16, 22
Hygienic Products Co. v. Coe, 85 F (2d) 264, 265 ..... 24
In Re Pitney-Bowes Postage Meter Co., 6 F (2d) 717..16, 27
Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537 .....16, 32
Menendez v. Holt, 128 U. S. 514 .....5, 16, 32
President Suspender Co. v. Macwilliam (C. C. A. 2), 238 Fed. 159, cert. den. 343 U. S. 636 .....5, 16, 26
Sawyer v. Kellogg (New Jersey), 7 Fed. 720 .....16, 27
Scandinavia Belting Co. v. Asbestos and Rubber Works of America (C. C. A. 2), 257 Fed. 937, cert. den. 250 U.S. 644 ..... 26
Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186 5, 10, 16, 20, 32
United States v. Forness (C. C. A. 2), 125 F (2d) 928..17-36

## STATUTES CITED.

Judicial Code (as amended February 13, 1925), Sec. 240(a), Chapter 229, 43 Stat. 936 ..... 11
R. S. 4915, Title LX, 53 Stat. 1212, 35 U. S. C. 63 .....5, 24
Trade-Mark Act of February 20, 1905 (as amended), 33 Stat. 727, 15 U. S. C. A. 85 .....4, 14

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DIXIE ROSE NURSERY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

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## MOTION TO PROCEED ON CERTIFIED TRANSCRIPT OF THE RECORD AND ORIGINAL EXHIBITS FOR THE PURPOSES OF PETITION FOR WRIT OF CERTIORARI AND TO DISPENSE WITH PRINTING OF EXHIBITS.

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Now comes, Dixie Rose Nursery, petitioner in the above-entitled cause, and moves that petitioner be permitted to proceed, for the purposes of the annexed petition, on the certified transcript of the record and the original exhibits in the District Court and the United States Court of Appeals for the District of Columbia, in lieu of a printed record as required by Rule 38, par. 7, of the Rules of the Supreme Court.

In support of the above motion, petitioner respectfully submits that during the trial of this case in the District

Court a large number of paper exhibits were offered in evidence, said exhibits comprising over 100 printed copies of trade-mark registrations, and numerous excerpts from magazines, trade catalogs and other publications, each containing a large number of pages, many of which are in color. Accordingly, the cost of reproducing these exhibits in a printed record would be prohibitive and more than petitioner would be able to bear. For the same reasons, a motion to dispense with printing of an Appendix to petitioner-appellant's brief was granted by the Court of Appeals during the proceedings in that Court.

However, if the petition for writ of certiorari is granted by this Honorable Court, and petitioner is relieved from printing the exhibits, then and in that event, petitioner is ready and willing to print the record proper, should such be required by the Court.

Respectfully submitted,

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
*Attorneys for Petitioner.*

IN THE

# Supreme Court of the United States

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DIXIE ROSE NURSERY, *Petitioner*,

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CONWAY P. COE, Commissioner of Patents, *Respondent*.

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## PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

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*To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:*

Your petitioner, Dixie Rose Nursery, respectfully prays for a writ of certiorari to the United States Court of Appeals for the District of Columbia, to review a judgment of that Court entered November 16th, 1942 (petition for rehearing denied December 23, 1942). A transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith in accordance with Rule 38 of the Rules of this Court.

## I.

## SUMMARY STATEMENT OF MATTER INVOLVED.

This case involves the construction of the Trade Mark Act of February 20, 1905 (33 Stat. 727, 15 U. S. C. A. 85, Section 5).

The subject matter of this suit is the right of registration under the above Act of petitioner's trade-mark comprising the words "Texas Centennial" imposed upon a crude map outline base approximating the outline of the State of Texas, said trade-mark being used in interstate commerce by petitioner and its licensees upon roses, scions, and cuttings.

Respondent refused registration of petitioner's trade-mark in the proceedings in the U. S. Patent Office on the ground that the trade-mark in question is the name of a particular patented variety of rose, and is therefore descriptive, and further, that because the mark includes the word "Texas" and map outline, the mark is also geographical, and, therefore, for these reasons, is unregistrable under the inhibitions of the Act of 1905.

Petitioner contended before the Patent Office that the provisions of Section 5 of the Trade Mark Act of 1905 do not prohibit registration of its trade-mark, and that the refusal to register constituted a discrimination against petitioner, in the face of the long established practice followed by the Patent Office of registering variety trade-marks, including those containing undisclaimed geographical features, used in all industries, and even in the plant industry.

Petitioner further contended that its mark was neither descriptive nor geographical and that varietal names of plants, like varietal names of other articles, are registrable irrespective of the existence of a live patent on the article. After final rejection of its application, affirmance on appeal to the Commissioner of Patents in person, and denial of a petition for rehearing, petitioner filed suit in the United States District Court for the District of Columbia, under

Section 4915 R. S.[1] to authorize the Commissioner of Patents to register its trade-mark.

Judgment was rendered by the District Court in favor of respondent, without any opinion, and this judgment was affirmed by the United States Court of Appeals for the District of Columbia on the wholly new theoretical grounds and misapplication of the rule of this Court laid down in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, and approved by this Court in *Dupont Cellophane Co., Inc.* v. *Waxed Products Co., Inc.* (C. C. A. 2), 85 F. (2d) 75, cert. den. 304 U. S. 575, and in opposition to other principles of trade-mark law established by this and other Circuit Courts of Appeals, particularly in *Menendez* v. *Holt*, 128 U. S. 514, and *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251, all as set out in the opinion below dated November 16th, 1942, the said grounds being unsupported by the evidence adduced before the trial court, and therefore in direct opposition to the rule approved by this Court in *President Suspender Co.* v. *Macwilliam* (C. C. A. 2) 238 Fed. 159, cert. den. 343 U. S. 636, and long established practice of the Patent Office.

Petition for rehearing was denied by the Court of Appeals on December 23rd, 1942.

**The Facts.**

(1) On April 24, 1936, petitioner filed in the U. S. Patent Office a formal application for registration of its trade-mark, alleging commencement of use of the mark in interstate commerce on November 1, 1935, as applied to roses, scions and cuttings.

(2) The Examiner of Trade-Marks rejected the application on the ground that "the words 'Texas Centennial' . . . merely indicate a variety name of a particular rose" and should, therefore, be disclaimed (Pl. Ex. #1, Paper #1, p. 3). The Examiner further held, moreover, that the words were "the name of a patented article" (Pl. Ex. #1,

[1] R. S. 4915, U. S. C. A., Title 35, Section 63.

Paper #10, p. 42), and the registration would, therefore, "tend to extend a monopoly" (Pl. Ex. #1, Paper #8, p. 27).

(3) Upon final rejection of the application for registration on the foregoing grounds (Pl. Ex. #1, Paper #12, p. 47), petitioner appealed to the Commissioner of Patents in person, who, by decision of the Assistant Commissioner, overruled the rejection of the Examiner so far as based upon the ground that registration should be refused because the rose was patented (Pl. Ex. #1, Paper #19, pp. 63-65), but affirmed the Examiner's refusal to register on the ground that the words "Texas Centennial" as used upon the goods, are devoid of trade-mark significance because employed as a variety name and listed as such in petitioner's catalogs (Pl. Ex. #1, Paper #19, p. 64).

(4) As a new ground of refusal of registration, after close of the prosecution of the application for registration, the Assistant Commissioner further held that the word "Texas" and shape outline of the State of Texas are geographical "and therefore disclaimer on that ground would be required even were the mark otherwise unobjectionable" (Pl. Ex. #1, Paper #19, p. 65).

(5) In connection with the contention of the petitioner that its mark should be registered on the same basis that other variety trade-marks had been registered for many years in virtually all classes of goods, the Assistant Commissioner ruled ". . . that the registrability of trade-marks for plants should be determined upon precisely the same considerations as those that govern the registrability of trade-marks for any other articles of commerce." (Pl. Ex. #1, Paper #19, p. 63).

(6) Upon denial of a petition for reconsideration, the petitioner on October 18th, 1940, commenced an action under Section 4915 R. S. to authorize the Commissioner of Patents to issue to petitioner a certificate of registration of its trade-mark.

(7) Judgment was rendered on January 5, 1942, by the District Court, without opinion, in favor of respondent (Tr. 9).

(8) The judgment of the District Court was affirmed by the United States Court of Appeals for the District of Columbia. The opinion of the Court of Appeals is reported in 131 F. (2d) 446, and appears at pages 105 and 106 of the record transcript.

**The Trial Below.**

In the trial below, petitioner adduced full and complete evidence and proved adoption and use of the mark upon the goods continuously since the year 1935 (Tr. 41, 42), and the intent and purpose of the mark to show the origin or source of the goods in the petitioner company (Tr. 43). Petitioner also proved ownership of Plant Letters Patent No. 162, dated January 21, 1936, covering the particular variety of rose plant upon which the trade-mark in issue is used (Tr. 45), the wide propagation and distribution of the plants solely by petitioner and its licensees, throughout the United States (Tr. 45, 46), extensive advertising of the goods under the trade-mark name (Tr. 46), and the use and advertising of a separate generic or descriptive name "Red Hoover" by which the plants are known to the trade and to the public, apart from the trade-mark here in issue (Tr. 46), and the botanical classification of the variety as a Hybrid Tea Rose (Tr. 47).

Petitioner further proved by the testimony of two nationally outstanding and widely known nurserymen, Paul C. Stark of Stark Bros. Nurseries & Orchards Co., and Charles H. Perkins of Jackson & Perkins Co., the custom in the trade of applying trade-marks to and registering trade-marks for different varieties of plants in the same manner and for the same purposes as trade-marks are used and registered in other fields of commerce (Tr. 70, 71, 74-77, 81), and the recognition by the public and by the trade that petitioner's mark here in issue denotes origin of the goods

in petitioner (Tr. 68, 75). This testimony was fully corroborated by a grocer of long experience in respect to the custom of the grocery trade to use registered trade-mark names to identify and distinguish between different varieties of goods of different manufacturers commonly sold in grocery stores (Tr. 54 to 62 inclusive), such as "Ivory," "Swan," "P and G," etc. for different varieties of soaps; "Post Toasties," "Krumbles," "Pep," etc. for different varieties of cereals; "Raleigh," "Lucky Strike," "Herbert Tareyton," "Chesterfield," etc. for different varieties of cigarettes. Petitioner further proved the registration of the variety trade-marks "Richared," "Blackjon," "Seeando," etc. for different varieties of apples; and even "Texas Centennial" for a variety of wine.

Over 100 trade-mark registrations, selected at random, were produced in evidence by petitioner, said registrations covering the trade-marks registered for the different varieties of goods above mentioned and many others, these registrations having been granted throughout the period from the enactment of the Trade Mark Act of 1905 up to the present time.

*Petitioner's evidence was wholly unrebutted and uncontradicted,* since the only evidence offered by respondent consists merely of excerpts from the record in the Patent Office (Statement of the Trade-Mark Examiner and decisions of the Assistant Commissioner of Patents holding petitioner's mark to be unregistrable), and copies of three publications listing petitioner's roses by the trade-mark name here in issue and the patent number. Of these three publications, the two catalogs (Def. Exs. 3 and 4) described the plants as a sport of the variety "President Herbert Hoover."

**The Decisions Below.**

The District Court wrote no opinion, but found as matter of fact that the trial evidence established that "Texas Centennial" is the variety name of the rose covered by Plant Patent No. 162, and produced and sold by petitioner and by others under license from petitioner, and that this

name has not been applied to any other rose or plant. In spite of the total lack of rebuttal of petitioner's evidence of extensive registration and commercial use of trade-marks on particular varieties of goods, including plants, the Court then came to the conclusions that the words "Texas Centennial," being a variety name, are descriptive of roses to which these words are applied and therefore cannot be registered under the Trade Mark Act of 1905. The District Court further concluded that the word "Texas" and the outline of the map of the State of Texas are merely geographical, and because of petitioner's failure to disclaim them, petitioner is not entitled to registration under the Trade Mark Act of 1905, *although no requirement of such disclaimer had ever been made by either the Patent Office Examiner, or the Commissioner of Patents in the proceedings before the Patent Office.*

These findings were prepared by counsel for respondent without benefit of opinion or expression of views of the District Court as to the trial evidence, and were adopted by the Court in preference to the findings submitted by counsel for petitioner in opposition to respondent's findings. Thus, in effect, the findings adopted by the Court merely carry forward and reflect the erroneous views of the Patent Office, as advanced by the Trade Mark Examiner and the Assistant Commissioner of Patents during the prosecution of the application for registration, without regard to the contrary evidence adduced by petitioner before the trial court, and without regard for the principles of trade-mark law as established by this and other courts.

The United States Court of Appeals for the District of Columbia, on appeal to that Court, affirmed the decision of the District Court, and in so doing, expressed the view that *any name,* at first arbitrary and not descriptive, applied to a newly invented thing and to nothing else *for a considerable time,* would come to identify or describe the thing, as the word "cellophane" has come to describe a thing. In expressing this view, purporting to be based upon the rule of *Dupont Cellophane Co., Inc.* v. *Waxed Products Co.,*

*Inc.* (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575 (where the patent on the goods had expired and the goods had no other name than "cellophane", and this name had never been used in any other than a descriptive sense), the Court erroneously held that the statute forbids the registration of the words "Texas Centennial" unless an exception is read into the statute to the effect that words which are descriptive may nonetheless be registered when the applicant and his licensees are, for the moment, the only persons who produce the thing described. This holding was based upon the theory that to allow registration of a trademark such as here involved, would give to petitioner an unfair advantage and would tend to prolong petitioner's monopoly beyond the life of its patent, by making it difficult for a newcomer to break into the field, despite the fact that only petitioner here and its licensees now produce the patented goods under a patent *which has not yet expired,* and which is a far different situation from that considered by this Court in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, upon which the Court of Appeals relies.

These startling conclusions of the Court of Appeals are manifestly contrary to the accepted and usual course of judicial proceedings in which the findings of fact are based, and judgment entered, only on evidence adduced, and thus were reached under constraint or misapplication of a doctrine or rule of decision announced and applied by this Court in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, and variously applied by the lower courts, as in *Dupont Cellophane Co., Inc.* v. *Waxed Products Co., Inc.* (C. C. A. 2), 85 F. (2d) 75, 80, cert. den., 304 U. S. 575, and others.

In passing on the question of geographical character of certain features of petitioner's composite trade-mark, the Court of Appeals merely held that the addition of the geographical name "Texas" and map does not entitle the mark to registration, and to this extent the finding by the District Court to the effect that a disclaimer was prerequisite to registration of the composite mark as a whole, is not

definitely affirmed, thus leaving this particular issue unsettled.

## II.

## STATEMENT OF JURISDICTION.

The judgment of the United States Court of Appeals for the District of Columbia was entered November 16, 1942, and a petition for rehearing was denied December 23, 1942. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of Feb. 13, 1925, Chapter 229, 43 Stat. 936, and under the rules of practice and procedure of this Court, and petitioner respectfully prays that this Honorable Court exercise its right of judicial discretion to review the judgment below which involves, among other things, an interpretation of a Federal Statute (The Trade Mark Act of February 20, 1905, 33 Stat. 727, 15 U. S. C. A., par. 85), and a matter of interest and importance to the public generally, as well as to the litigants involved herein.

## III.

## THE QUESTIONS PRESENTED.

The following basic questions are involved in this cause and are here presented to this Honorable Court for consideration:

(1) Whether or not petitioner's composite trade-mark is registrable under the Trade Mark Act of 1905, for a variety of goods, namely, a variety of plant (said trade-mark consisting of the words "Texas Centennial" imprinted upon a base having a rough outline approximating the map outline of the State of Texas, and said trade-mark being applied by petitioner in interstate commerce upon the goods described in its application for registration as roses, scions, and cuttings);

(a) Whether or not petitioner's trade-mark as a whole, and more particularly the word feature "Texas

Centennial," is descriptive of petitioner's roses in the sense of the inhibitions of Section 5 of the Trade Mark Act of 1905;

(b) Whether or not the District Court and the Court of Appeals below committed error in failing to find that the word feature "Texas Centennial" is not descriptive of petitioner's roses in the light of the evidence adduced before the trial court which clearly establishes that the generic or descriptive name of said roses is "Red Hoover" and was so recognized by the public and by the trade, not only prior to, but also concurrently with and subsequent to the adoption of the "Texas Centennial" mark, and the filing of application for registration of the latter;

(c) Whether or not, in the light of the long established practice of registering variety names of varieties of goods, the Trade Mark Act of 1905 prohibits registration of the composite trade-mark "Texas Centennial" and map outline, where the word feature "Texas Centennial" constitutes the variety name of the rose known to the trade and to the public by the generic or descriptive name "Red Hoover";

(d) Whether or not a trade-mark, originally arbitrary and not descriptive of a new product, becomes descriptive of such product, and therefore unregistrable under the Trade Mark Act of 1905, merely if the mark is applied for a considerable period to that product and to nothing else, when the proprietor and his licensees, for the moment, are the only persons who produce the goods to which the trade-mark is applied;

(e) Whether or not the period from petitioner's commencement of use of its trade-mark in November 1935 up to the date of filing of application for registration on April 24, 1936, or to any other date established by the evidence in this case, may properly be considered as such a considerable period of use of the

mark upon the particular goods, and upon nothing else, as to presume or imply, without positive proof, the acquisition of descriptiveness inhibited by the Act;

(f) Whether or not a trade-mark originally arbitrary and not descriptive, loses its trade-mark significance when listed in a catalog or catalogs of the proprietor or his licensees.

(2) Whether or not the Trade Mark Act of 1905 prohibits registration of a trade-mark where the application for registration is filed before the grant or expiration of the patent upon the goods:

(a) Whether or not registration of petitioner's trade-mark during the life of its patent, granted after adoption of the mark and filing of application for registration, would unreasonably or unfairly prolong petitioner's monopoly beyond the life of the patent, where the trade-mark was originally arbitrary and not descriptive, and the goods were originally and are concurrently known by a separate generic trade name.

(3) Whether or not a disclaimer of a geographical feature or features of a composite trade-mark is an essential prerequisite to registration of such composite mark as a whole under the Trade Mark Act of 1905:

(a) Whether or not the decision of this Court in *Estate of P. D. Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, approving of voluntary disclaimers in lieu of physical obliteration of disclaimed features from the drawings of trade-mark applications, must be construed as compelling entry of disclaimers of all descriptive or geographical features of trade-marks as a prerequisite to registration under the Trade Mark Act of 1905, when said Act itself contains no provision for or requirement of such disclaimers.

(4) Whether or not the findings below reflect the facts to a degreee that is sufficient to support the judgment below in the light of all of the evidence and the pertinent principles of law.

(5) Whether or not there was a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure in the adoption by the District Court of findings prepared by counsel for respondent, without benefit of any expression, either oral or written, of views of the Court as to the evidence or principles of law justifying a judgment for respondent.

## IV.

## STATUTE INVOLVED.

The portion of Section 5, involved here, of the Trade Mark Act of February 20, 1905 (As Amended), 33 Stat. 727, 15 U. S. C. A. 85, reads as follows:

> "Sec. 5. U. S. C., title 15, sec. 85. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—
>
> (a) Consists of or comprises immoral or scandalous matter.
>
> (b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, *or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: Provided, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: Provided,* That trade-marks which are identical with a registered or known trade-mark owned and

in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act; . . . ."

## V.

## REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

The discretionary power of this Court to grant a writ of certiorari is invoked upon the following grounds as set forth in Rule 38 of the rules of this Court:

(1) That the United States Court of Appeals for the District of Columbia, in holding petitioner's variety trade-mark to be unregistrable, has decided a question of general interest and importance to a large industry (plant industry) and to the general public, and which decision casts a cloud on many variety trade-mark registrations granted by the United States Patent Office previous to this decision, which registrations have been issued for varieties of goods not only in the field of plant life, but also in numerous other fields of commercial enterprise.

(2) That the United States Court of Appeals for the District of Columbia has, in denying petitioner's right to registration, decided a question of substance relating to the Federal Trade Mark Act of 1905, which has not been but which should be settled by this Court. (This is the first case, as far as petitioner is aware, in which a court has held,

before expiration of the patent, that a trade-mark applied to a patented product, loses its trade-mark significance by exclusive use on such product alone, and upon nothing else.)

(3) That the United States Court of Appeals for the District of Columbia, in holding petitioner's trade-mark to be unregistrable, has misunderstood and misapplied the doctrine of *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, and *Dupont Cellophane Co., Inc.* v. *Waxed Products Co., Inc.* (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575, (in view of the fact that these cases concern the validity of a *registered* trade-mark *after* expiration of the patent on the goods to which the registed mark had been applied, and therefore do not constitute any authority for prohibiting registration of a trade-mark *before* the grant or expiration of the patent when the mark admittedly might properly have been held to be arbitrary and not descriptive at the time of adoption of the mark and filing of application for registration prior to issuance of the patent on the goods).

(4) That the United States Court of Appeals for the District of Columbia, in construing the Trade Mark Act of 1905 to forbid registration of petitioner's trade-mark (notwithstanding the admission by the Court that the mark might properly have been held to be "originally arbitrary"), has decided an important question of Federal law in conflict with former decisions of this Court,[1] in conflict with the decisions of other Circuit Courts of Appeals,[2] in

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[1] (Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186; Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251; Menendez v. Holt, 128 U. S. 514; Lawrence Mfg. Co. v. Tennessee Mfg. Co., 138 U. S. 537; Estate of P. D. Beckwith v. Commissioner of Patents, 252 U. S. 538.)

[2] (Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc. (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575; President Suspender Co. v. Macwilliam (C. C. A. 2), 238 Fed. 159, cert. den. 343 U. S. 636; Sawyer v. Kellogg (New Jersey), 7 Fed. 720; Batcheller v. Thompson (C. C. A. 2), 93 Fed. 669; In Re Pitney-Bowes Postage Meter Co. (App. D. C.) 6 F. (2d) 717.)

conflict with the Trade Mark Act of 1905, and in conflict with the practice of the Patent Office throughout the period from the enactment of the Trade Mark Act of 1905, up to the present date.

(5) That the United States Court of Appeals for the District of Columbia has based its decision upon an erroneous presumption of descriptiveness and loss of trade-mark significance of petitioner's mark, and/or not upon evidence before it on the substantive issues of the case, and has in that respect so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

(6) That the United States Court of Appeals for the District of Columbia has failed to recognize and determine the issue brought to that Court, involving the question of sufficiency of compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in respect to the adoption by the District Court below of findings prepared by counsel for respondent without benefit of any written or oral opinion of the Court, and without any other expression of views of the Court as to any evidence in the case upon which the findings so adopted are properly supported, and in that respect, the proceedings below so far departed from the accepted and usual course of judicial proceedings, condemned in *United States* v. *Forness* (C. C. A. 2), 125 F. (2d) 928, as to call for an interpretation by this Court of the meaning and intent of said Rule 52(a), in the exercise of this Court's power of supervision.

Wherefore, your petitioner, being without other effective remedy, prays that a writ of certiorari under Section 240(a) of the Judicial Code as amended by the Act of Feb. 13, 1925, be issued out of and under the seal of this Honorable Court, directed to the United States Court of Appeals for the District of Columbia, commanding said Court to certify and send to this Court a full and complete transcript of the record and all the proceedings of said United

States Court of Appeals for the District of Columbia had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the United States Court of Appeals for the District of Columbia may be revised and reversed; and that your petitioner may have such other and further relief or remedy in the premises as to this Court may seem appropriate and just.

Dated, February 17, 1943.

DIXIE ROSE NURSERY,

By HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
*Attorneys for Petitioner.*

District of Columbia, ss:

Harry C. Robb, John F. Robb, and Harry C. Robb, Jr., being duly sworn, depose and say that they are the attorneys for the petitioner herein; that they prepared the foregoing petition; that the allegations thereof are true as they verily believe, and that the foregoing petition is well founded in point of law and is not filed for delay.

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.

Subscribed and sworn to before me this 17th day of February, 1943.

CHRISTIE H. FESLER,
*Notary Public.*

(Seal)

My commission expires Oct. 15, 1943.

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1942.

No. ———.

DIXIE ROSE NURSERY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

## BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

### JURISDICTION.

The statement of jurisdiction is set forth in the foregoing petition.

### STATEMENT OF THE CASE.

The facts have been set forth in the foregoing petition.

### SUMMARY OF ARGUMENT.

#### Point I.

The limitation contained in Section 5 of the Trade-Mark Act of 1905, prohibiting registration of *merely* descriptive or *merely* geographical marks, was solely intended to deny registration to those marks which are descriptive or geographical *as a whole.*

#### Point II.

Descriptiveness or geographical significance of a trade-mark may not properly be presumed or implied in the absence of strict and positive proof of such descriptiveness or geographical significance.

**Point III.**

The monopoly afforded by registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent.

**Point IV.**

The history of the trade-mark practice before the Patent Office and as interpreted by this Court and other courts of the land, does not deny the right of registration to variety trade-marks for varieties of goods including varieties of plants.

**Point V.**

The rule in *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, and *Dupont Cellophane Co., Inc.* v. *Waxed Products Co., Inc.* (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575 does not apply to the facts and evidence in the case here before the Court.

**Point VI.**

Disclaimer of descriptive or geographical features of composite trade-marks is not a prerequisite to registration under the Trade Mark Act of 1905, when the trade-mark as a whole is not merely descriptive or merely geographical.

**Point VII.**

Adoption by a trial court of findings prepared and submitted by the winning party to the suit, as in this case, is not a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in the absence of a written or oral opinion or expression of views of the court as to the sufficiency of the trial evidence to support the judgment of the court.

**Point VIII.**

This case is one of first impression.

## ARGUMENT.

### Point I.

**The limitation contained in Section 5 of the Trade-Mark Act of 1905, Prohibiting Registration of MERELY Descriptive or MERELY geographical marks was solely intended to deny registration to those marks which are descriptive or geographical as a whole.**

The Trade-Mark Act regulating registration of trade-marks is an outgrowth of the broader principles of law established for the purpose of preventing unfair competition in trade. The sole intent of those provisions of the Act which prohibit registration, is to avoid the likelihood of confusion in the mind of the public as to the origin or identity of the merchandise to which the trade-marks are applied.

Section 5 of the Act, which is the section we are particularly concerned with here, prohibits registration of trade-marks which are merely descriptive or merely geographical. The clause in question reads as follows:

> "*Provided,* That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act:"

It will be observed that the words of the Act explicitly designate the inhibition against those marks which consist merely in words or devices which are descriptive of the goods, or of the character or quality of such goods. The language is not so broad as to inhibit registration of a composite trade-mark which is made up of arbitrary or fanciful features, plus a descriptive or geographical feature.

Accordingly, the only proper construction of the Act requires that the registrability of a composite trade-mark must be determined in the light of the mark *as a whole,* and not from its individual elements separately.

In this respect, the case comes within the principle applied by this Court in Estate of *P. D. Beckwith* v. *Commissioner of Patents* (252 U. S. 538), where this Court, in passing on this very question, stated:

> "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety."

The question of geographical significance of composite trade-marks was likewise passed upon by this Court in the case of *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.,* 240 U. S. 251, where this Court appropriately stated the applicable principle as follows:

> "We do not regard the words 'The American Girl,' adopted and employed by complainant in connection with shoes of its manufacture, as being a geographical or descriptive term. It does not signify that the shoes are manufactured in America, or intended to be sold or used in America, nor does it indicate the quality or characteristics of the shoes. Indeed, it does not in its primary signification, indicate shoes at all. It is a fanciful designation, arbitrarily selected by complainant's predecessors to designate shoes of their manufacture. We are convinced that it was subject to appropriation for that purpose. * * *
>
> The cases cited to the contrary are distinguishable. In *Delaware & H. Canal Co.* v. *Clark* (13 Wall. 311, 324, 20 L. Ed. 581, 583), the word 'Lackawanna' was rejected as a trade-mark for coal because it designated the district in which the coal was produced. * * * If the mark here in controversy were 'American Shoes,' these cases would be quite in point. * * * The phrase is quite analogous to 'American Express', held to be properly the subject of exclusive appropriation as a trade-mark for sealing wax in *Dennison Mfg. Co.* v. *Thomas Mfg. Co.,* (94 Fed. 651, 653)."

The foregoing cases have clearly established and settled the true meaning and intent of the language of the Trade Mark Act, and have served as a guide to the practice for many years. The only explanation for the grant of thousands of registrations for variety trade-marks which have been issued since the enactment of the Trade Mark Act up to the present date, and of which the many registrations of petitioner's exhibits here in evidence (Pl. Exs. 3, 4, 12, 13, 14, 15, 16, 17, 19 and 20) are illustrative, is to be found in the above interpretations of the Act by this Court.

Construing the Act in the light of the foregoing principles, it follows that petitioner's composite trade-mark is neither descriptive of the goods nor geographical within the meaning of the inhibitions of the Act.

With all deference to the Patent Office and the courts below, we submit that the language of the Act under consideration has been too broadly applied, so far as petitioner's trade-mark has been held to be descriptive of a particular variety of rose and therefore is unregistrable under the Act. Neither the words "Texas Centennial" alone, nor the mark as a whole describes a rose or any character or quality of a rose. If the mark were merely "Texas Roses", then it might properly have been held that the mark was both descriptive and geographical, but that is not the mark here in issue. On the contrary, paraphrasing the language of this Court in the Hamilton-Brown Shoe case, *supra*, petitioner's mark does not signify that the roses are grown or produced in Texas, or intended to be sold in Texas; nor in fact does the mark in its primary signification indicate roses at all.

## Point II.

**Descriptiveness or geographical significance of a trade-mark may not properly be presumed or implied in the absence of strict and positive proof of such descriptiveness or geographical significance.**

Petitioner, essaying under Section 4915 R. S., to try in a court of equity the issue of registrability of its composite trade-mark "Texas Centennial" and design (determined adversely to it in the Patent Office proceedings), adduced abundant evidence of intention to adopt and use, and the fact of adoption and use of its mark in interstate commerce, commencing in November, 1935 (Tr. 41, 42); filing of application for registration of the mark in April, 1936, (Pl. Ex. No. 1) as applied to roses, scions and cuttings of the new variety then and since known to the trade and to the public in general by the generic or descriptive name "Red Hoover" (Tr. 41-46) (a red sport of the earlier known yellow rose variety "President Herbert Hoover"); patenting of the new variety in January, 1936 (Tr. 45); extensive advertising of the rose under the trade-mark "Texas Centennial" in association with the generic name "Red Hoover" (Pl. Exs. 5, 6 & 7, 33); and the understanding by and meaning to the trade and to the public that the mark was truly significant of origin in petitioner, and was employed in precisely the same manner as variety trade-marks have been universally used upon many different varieties of goods in other fields of commerce (Tr. 42, 43 and 54-83 inc.).

This was all in accordance with the course of equity and the usual and correct practice in a suit under Section 4915 R. S., which applies to trade-mark cases as well as to patent cases (U. S. ex rel, the *Baldwin Company* v. *Robertson*, 265 U. S. 168, 179; *Hygienic Products Co.* v. *Coe*, 85 F. (2d) 264, 265.

*Respondent, however, adduced no countervailing evidence whatever.*

Petitioner's evidence having abundantly proved that the trade-mark denotes origin of the goods in petitioner, as

was originally intended, was so understood by the trade and by the public, and is not descriptive of the goods, this put respondent to its proofs to the contrary. Respondent's failure to adduce any countervailing evidence, left the Courts below, we submit, nothing to do but enter judgment for petitioner.

In spite of the only evidence in this case establishing the truly arbitrary and non-descriptive character of petitioner's mark here in issue, the District Court below rendered judgment in favor of respondent. The District Court wrote no opinion, but found as matter of fact that the trial evidence established that "Texas Centennial" is the variety name of the rose covered by Plant Patent No. 162, and produced and sold by petitioner and by others under license from petitioner, and that this name has not been applied to any other rose or plant. These findings appear at page 7 of the transcript of the record. The District Court then came to the conclusions that the words "Texas Centennial", being a variety name, are descriptive of roses to which these words are applied, and, therefore, cannot be registered under the Trade Mark Act of 1905. These conclusions are found at page 8 of the transcript of the record.

The Court of Appeals, on appeal to that Court, affirmed the judgment of the District Court dismissing the complaint (see order of dismissal, Tr. 107), said affirmance being based upon a wholly new theory that if a name originally arbitrary and not descriptive, is applied for a considerable period to a new invention and to nothing else, the name would come to identify or describe the thing as the word "cellophane" has come to describe a thing. In this connection, the Court of Appeals gave no guide for the meaning of the expression "considerable period", and in referring to the "cellophane" illustration it has misapplied a doctrine, there involving a period extending beyond the life of a patent, to the facts of the present case where the application for registration was applied for in the Patent Office less than five months after adoption and use of the mark upon the goods.

Thus, the descriptive significance ascribed by the Court of Appeals below to petitioner's trade-mark is a presumption not supported or justified by the evidence in the case. The presumption is, accordingly, at variance with the principle of law long established in trade-mark practice and approved by this Court, as found in the case of *President Suspender Co.* v. *Macwilliam* (C. C. A. 2), 238 Fed. 159, cert. den. 343 U. S. 636. In that case the Court said:

> "The fact that the name 'President' has come to indicate the invention and constitutes its generic description is one of fact, to be proved by evidence. There is no evidence in this record that the word 'President' has ever come to indicate to the public the generic description of the suspender of the patent. The only evidence in the case indicates that it is a mark of origin, indicating the plaintiff, its business, and its goods. There is no presumption of law, without proof of the fact as above indicated, that a name used on a patented article passes to the public on expiration of the patent."

The foregoing applies precisely in the same manner to the unrebutted evidence offered by petitioner in the trial court below.

To the same effect is *Scandinavia Belting Co.* v. *Asbestos and Rubber Works of America* (C. C. A. 2), 257 Fed. 937, cert. den. 250 U. S. 644.

Were the principle of the President Suspender case, *supra*, applied to this case by the court below, the only proper conclusion which could have been reached by the court would have been that petitioner's trade-mark is registrable under the Act.

## Point III.

**The monopoly afforded by registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent.**

The conclusion of the Court of Appeals below to the effect that to allow registration of petitioner's trade-mark would give to petitioner an unfair advantage despite the fact that only petitioner and its licensees produce the particular variety of rose to which the trade-mark is applied, and that it would tend to prolong petitioner's monopoly beyond the life of its patent by making it difficult for a newcomer to break into the field, is completely at variance with a former decision of that Court in the case of *In Re Pitney-Bowes Postage Meter Co.*, 6 F. (2d) 717. In that case, the Court appropriately recognized that the monopoly afforded by the registration of a trade-mark is wholly separate and distinctly different from the monopoly afforded by a patent. This principle has been repeatedly announced by various Circuit Courts of Appeals which have held that a subsequently granted patent on the article cannot affect the established trade-mark, as exemplified by the following cases, namely:

*Sawyer* v. *Kellogg* (C. C. D. N. J.), 7 Fed. 720;
*Batcheller* v. *Thompson* (C. C. A. 2), 93 Fed. 660.

In fact, the monopoly afforded by a statutory registration under the Act of 1905, is not a monopoly at all on either the goods or the words themselves. That is to say, registration of a trade-mark does not create any *new right* which is greater than the right of freedom from unfair competition afforded by the common law, but on the contrary, registration goes to the codification of the administrative procedure of registration, and the remedies for infringement to give greater effect to the protection against unfair competition. As this Court well knows, most of the articles of commerce today are patented, and to prohibit registration, during the life of the patents, of those trade-marks used on

patented articles or patented plants, as in the case here, would constitute judicial legislation because such prohibition is not found in the Trade-Mark Act itself, and would bar registration of the majority of trade-marks. This is clearly contrary to the intent and express terms of the Act.

This principle was apparently recognized in the instant case by the Assistant Commissioner of Patents who overruled the rejection of petitioner's application for registration by the Examiner of Trade Marks, so far as based on the ground that petitioner's mark was the name of a patented article. Therefore this question was not made an issue in the proceedings under 4915 R. S., as the pleadings show, in spite of which, the judgment below appears to have been based primarily on the very existence of a patent on the goods, and to that extent, petitioner has been penalized for having obtained a patent after applying for registration of its trade-mark, notwithstanding the common practice of the Patent Office to register trade-marks for patented products.

Having in view that the evidence here shows that petitioner's patent on the goods has not expired, and was in fact granted after filing of application for registration of the trade-mark, there is no proper basis for the conclusion of the Court of Appeals below that the grant of registration of the mark in issue would extend petitioner's monopoly beyond the life of its patent.

## Point IV.

**The history of the trade-mark practice before the Patent Office and as interpreted by this Court and other courts of the land, does not deny the right of registration to variety trade-marks for varieties of goods including varieties of plants.**

The numerous registrations (such as "Ivory", "P and G", "Swan" etc., for different varieties of soaps; "Post Toasties", "Krumbles", "Pep" etc., for different varieties of cereals; "Lucky Strike", "Herbert Tareyton". "Ches-

terfield" etc., for different varieties of cigarettes; "Blackjon," "Seeando," "Richared" etc., for different varieties of apples; "Texas Centennial" for a variety of wine, etc.) granted over a period of many years since the passage of the Trade Mark Act of 1905, as evidenced by those hundred or so registrations selected at random and offered in evidence by petitioner, show quite clearly the manner in which the Act has been consistently interpreted by the Patent Office and as fully justifying the registration of petitioner's mark.

As recently as January 6, 1943, since this case was decided by the Court of Appeals below, in Ex parte W. F. Hebard & Co., 56 U. S. P. Q. 114, the Assistant Commissioner of Patents Van Arsdale said:

> "To my mind, it is immaterial to the right of registration that the name 'shop mule' may not have been descriptive of an industrial tractor at the time applicant first adopted the mark for such machines. *It is the date of filing for registration that controls.*" (Italics ours)

Accordingly, even now the Patent Office is not giving effect to the theory of the decision below, any more than did the Patent Office apply its own customary rule of the Hebard case, *supra*, to the instant case, having in mind that petitioner filed application for registration within five months after adoption and use of its mark, and before the patent on the goods was obtained. If the date of filing controls, there obviously was no lapse of a considerable period of time comparable to the theory in the Singer and Cellophane cases, *supra*, where the time factor involved at least the full life of the expired patent (17 years).

Again, within three days after the decision below, the same Assistant Commissioner of Patents in Ex parte Eastman Kodak Co., 55 U. S. P. Q. 361, speaking with reference to the trade-mark "D-11" as applied to only one specific type of photographic developer upon which the mark "D-11" was used by the Eastman Kodak Company, held as follows:

"It seems to me the present mark is of the same class as the mark 'La Favorita' in Menendez v. Holt, 128 U. S. 514, 1889 C. D. 344, 46 O. G. 971. In that case it appears the marking of the goods included both the mark 'La Favorita' and the name of the distributor of the goods. The goods were a particular flour and the mark had been used to distinguish that particular flour selected and prepared by the distributor. The mark did not, in itself, indicate quality, being merely a fancy name, but the court found the mark evidenced that the distributor's skill, knowledge and judgment had been exercised in the selection of the flour. The court held that under such circumstances the mark 'deserves protection rather than that it should be debarred therefrom, on the ground, as argued, of being indicative of quality only.'

*Applicant's mark does not appear to denote or to be intended to denote type or quality only but is also intended to and does denote the origin of the goods.* In my opinion the mark gives amply sufficient indication of the origin of the goods to which the mark is applied to warrant allowance of the application and the passing of the mark to publication, *notwithstanding the fact that the labels show the mark applied to only one specific type of developer.* Menendez v. Holt, supra, Richard Hellman, Inc. v. Oakford & Fahnestock, 19 C. C. P. A. 816, 54 F. 2d 423, 1932 C. D. 160 (12 U. S. P. Q. 31).

In addition I may say that in my opinion if the mark 'D-11' were displayed on packages of photographic developers compounded and sold by others than applicant purchasers would be likely to be misled and deceived into believing that those developers were made by the Eastman Kodak Company. It seems that confusion as to source of origin of developers would be more likely to result from refusal to allow registration than from allowing registration, and it is an object of the Trade Mark Act to avoid such confusion. *Attention has been called to the fact that applicant has applied for trade mark registration of six other notations for developers compounded in accordance with other formulas, but this seems to be immaterial since it is conceded that the mark of the instant application serves as a grade mark; but as stated, I consider the mark also*

*is sufficiently indicative of the source of origin of the goods to which the mark is applied to entitle it to registration.* Also the examiner appears to concede that the mark indicates that the particular type of developer to which the mark is applied is made by applicant. The fundamental question is not whether or not the mark as used by applicant serves to indicate grade or quality but rather whether it is or is not so used that purchasers and the public will recognize the mark as indicating the source or origin of the goods. *I see no conflict between the authorities on this point.*" (Emphasis ours)

Still later, on January 21, 1943, the same Assistant Commissioner held the mark "5897", *as used upon a particular strain of seed corn,* to be a registrable mark under the Act of 1905, on the authority of *Menendez* v. *Holt* hereinbefore referred to (see *Ex parte Pfister Hybrid Corn Co.*, 56 U. S. P. Q. 275). The Assistant Commissioner said:

"Notwithstanding the fact that the mark may indicate one particular strain of applicant's seed corn nevertheless in my opinion the mark as it is applied to applicant's goods is sufficiently indicative of the true source of origin of the goods to which the mark is applied to entitle the mark to registration under Act of February 20, 1905."

A *strain* of seed corn is simply another term for *variety* as this latter term is referred to herein in connection with the variety trade-mark in issue for roses, and the hundred or so variety trade-mark registrations offered in evidence by petitioner.

Thus, the very history of the practice before the Patent Office is a far safer and more accurate guide to the intent and meaning of the Trade Mark Act of 1905 than the theoretical reasoning in the decision below. In other words, the Court of Appeals below has announced a wholly new theory or interpretation of the Trade Mark Act, which, if followed, would radically change the prevailing practice. In spite of this new theory or interpretation of the Act, the foregoing recent decisions of the Patent Office, coming after the decision below, show that the Patent Office even now is not following the court's theory, and unless this Court

grants the writ of certiorari, the decision below will stand as an unreasonable and unfair discrimination against petitioner, and in effect, against the entire plant industry.

Referring to the case of *Menendez* v. *Holt*, 128 U. S. 514, cited in the foregoing decisions of the Patent Office, this Court has there clearly established the principle that where the intention is to acquire a trade-mark, the mere fact that the name may also serve to designate a particular kind, grade, or quality of the article manufactured does not prevent the creation of a trade-mark right in it and does not prohibit registration of the mark under the Act of 1905.

Both the "La Favorita" trade-mark involved in the *Menendez* v. *Holt* case and the "Texas Centennial" mark in issue here, are variety trade-marks used on particular vendable commodities, and petitioner's composite trade-mark accomplishes a purpose precisely like that of the "La Favorita" trade-mark in the *Menendez* v. *Holt* case.

The same doctrine was reiterated by this Court in *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537, where it was further observed by this Court that the primary object of the adoption by the trade-mark proprietor of the trade-mark in question was to symbolize the exercise of the judgment, skill and particular knowledge of the proprietor who adopted and used it.

This doctrine was not changed by *Singer Mfg. Co.* v. *June Mfg. Co.*, 163 U. S. 169, 185, 186, which does not involve the question presented here, but rather which concerns the loss of trade-mark significance *after* expiration of the patent.

## Point V.

**The rule in Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186, and Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc. (C. C. A. 2), 85 F. (2d) 75, 80, cert. den. 304 U. S. 575, does not apply to the facts and evidence in the case here before the Court.**

As indicated above, the rule announced by this Court in the Singer case does not apply to the facts and evidence in the case here before the Court, and, therefore, the conclu-

sion of the Court of Appeals below to the effect that "It is conceived to be unfair to require buyers who are indifferent to source, and want merely goods of certain characteristics, to name a particular source in order to name the desired characteristics" is based upon a supposed constraint of a decision of this Court.

Nothing in the rule of the Singer case, properly understood and properly applied, compelled any result below other than the entry of judgment for petitioner, or justified the extension of the rule beyond the kind of suit (to wit, infringement of a *registered* trade-mark *after* expiration of the patent on the goods) and the situation of proofs (to wit, proofs definitely showing without necessity of presumption that the marks never had been used in other than a descriptive sense) there before the Court, for the reasons fully set out in the petition which need not be repeated.

Likewise, the Cellophane case relied upon by the Court of Appeals below is inapplicable to the case here before the Court for the same reasons mentioned above in connection with the Singer case.

The present case is definitely distinguished from both of the above cases by reason of the fact that petitioner's trade-mark was adopted and used before the grant of its patent, and the patent is even now not yet expired. Moreover, petitioner has applied its trade-mark to goods having a separate and distinct generic name "Red Hoover" well known to the public and to the trade in general, as distinguished from the use of trade-marks in no other but a descriptive sense in the Singer and Cellophane cases, and the absence of any other name by which the goods in those cases could be identified.

## Point VI.

**Disclaimer of descriptive or geographical features of composite trade-marks is not a prerequisite to registration under the Trade-Mark Act of 1905, when the trade-mark as a whole is not merely descriptive or merely geographical.**

In the proceedings before the Patent Office, the Assistant Commissioner of Patents, after the close of the prosecution of petitioner's application for registration, held that the word "Texas" and the shape outline of the State of Texas are geographical "and their disclaimer on that ground would be required even were the mark otherwise unobjectionable." This ruling was not strictly a requirement of disclaimer, but even if it were intended to be such a requirement, it came too late since the prosecution of the application was closed. However, if this Court should interpret its former decision in Estate of *P. D. Beckwith* v. *Commissioner of Patents* (252 U. S. 538), as intending to require disclaimer as prerequisite to registration, then such disclaimer can be entered in the case when it is remanded to the Patent Office, should the mark be otherwise adjudged registrable.

In spite of the absence of any definite requirement of disclaimer in the proceedings before the Patent Office, the District Court below found as a conclusion of law that the word "Texas" and map outline of the State of Texas are merely geographical and in view of petitioner's failure to disclaim them, the petitioner is not entitled to registration under the Act. (Tr. 8)

The Court of Appeals in passing on the question of geographical character of the mark, merely held that the addition of the geographical name "Texas" and map does not entitle the mark to registration, and to this extent, the finding by the District Court to the effect that a disclaimer is prerequisite to registration of the composite mark as a whole, is not definitely affirmed and leaves this particular issue unsettled.

The Beckwith case above referred to, as petitioner understands the purport of the decision of this Court there, was not intended to write into the Trade Mark Act a new requirement which is not referred to in the Act itself, having regard for the fact that the Act makes no provision whatever for disclaimers, and certainly does not require disclaimers of descriptive or geographical features of a composite mark. The particular situation before the Court in that case was whether voluntarily disclaimed subject matter had to be obliterated or erased from the drawing of the application for registration. The Court held that such obliteration or erasure was not necessary and went no farther than to express approval of the practice of permitting disclaimers in lieu thereof. Accordingly, this is a situation which should be elucidated by this Court in the application of the principle of the Beckwith case to suits based on the pleadings and proofs like the instant case, to the end that the rights and duties, and the proper practice and procedure of applicants for registration under the Trade Mark Act, may be clarified.

## Point VII.

**Adoption by the trial court of findings prepared and submitted by the winning party to the suit, as in this case, was not a sufficient compliance with rule 52(a) of the Federal Rules of Civil Procedure, in the absence of a written or oral opinion or expression of views of the court as to the sufficiency of the trial evidence to support the judgment of the court.**

One of the issues raised by this Petitioner in the Court of Appeals below, but which was not passed upon by that Court, involves the question of whether there was a sufficient compliance with Rule 52(a) of the Federal Rules of Civil Procedure, in the adoption by the District Court of findings prepared and submitted by counsel for respondent, without benefit of any expression of views of the Court whatever (either by opinion or otherwise) as to the trial

evidence. This practice has been condemned by at least one Circuit Court of Appeals as in the case of *United States* v. *Forness*, (C. C. A. 2), 125 F. (2d) 928, where the Court said:

> "We have recently asked for 'brief and pertinent findings of contested matters * * * rather than the delayed, argumentative, over-detailed documents prepared by winning counsel.' *Matton Oil Transfer Corp.* v. *Tug "Dynamic,"* 123 F. (2d) 999 (5 Fed. Rules Serv. 25a.11, Case 2) (Dec. 1, 1941). Otherwise, we lose the benefit of the judge's own consideration. In the instant case, a comparison of the findings with the opinion seems to show that the findings proposed by the defendants were mechanically adopted, with the consequence that some of the findings made by the district court are not supported by the evidence and not substantially in accord with the opinion."

The object of the rule in question is aptly stated in the discussion of the Federal Rules of Civil Procedure at page 27 of 1 F. R. D. by Judge Gunnar H. Nordbye of the U. S. District Court at Kansas City, who said as follows:

> "I like the clear and succinct statement of our text writer in Minnesota, Mark B. Dunnell, who states, in referring to the Minnesota statute:
> 'The objects of the statute to require the court to give its decision in writing and to state the facts found and conclusions of law separately, are to abolish the doctrine of "implied findings"; to make definite and certain just what is decided, not only for the purpose of the particular action, but also for the purpose of applying the doctrine of estoppel to future cases; and finally to separate questions of law and fact so that they may be more conveniently, intelligently and fairly considered and reviewed on a motion for a new trial or on an appeal.' "

Also, the following from page 29 of the same discussion:

> "I feel that counsel have a right to the judge's views and the reasons which prompted him to the decision which was reached. It tends to inform counsel that

some consideration at least has been given to the conflicting contentions that have been advanced, and that the views of losing counsel have not been simply brushed aside."

Accordingly, the issue raised in the present case calls for an interpretation by this Court of the meaning and intent of said Rule 52(a), in the exercise of this Court's power of supervision, in the determination of the question of whether the proceedings below so far departed from the accepted and usual course of judicial proceedings as to countenance the entry of a judgment below which is without evidence to support it and which is contrary to the only evidence adduced.

## Point VIII.

### This case is one of first impression.

The present case is the first case, as far as petitioner is aware, in which a court has held before expiration of the patent, that a trade-mark applied to a patented product, loses its trade-mark significance by exclusive use on such product alone, and upon nothing else.

This question has remained unadjudicated in any proceeding arising out of the proceedings in the Patent Office on an application for registration. For the reasons hereinbefore given, the rule of the Singer and Cellophane cases is not applicable, because these cases were dealing with a totally different question, namely, the loss of trade-mark significance of a *registered* trade-mark *after* expiration of the patent.

This case is also the first case, as far as petitioner is aware, in which the right of registration of a variety name trade-mark, as such, has been directly raised under the Trade-Mark Act of 1905.

Accordingly, if the judgment below is permitted to stand, petitioner will be denied its right to registration of its trade-mark under the Trade Mark Act upon a misinterpretation and misapplication of the rule in the Singer and Cellophane

cases, and the practice in the lower courts will be revolutionized without sanction of this Court and in direct opposition to former decisions of this and other Courts, as previously shown herein. Moreover, the decision of the Court of Appeals below casts a cloud upon thousands of registrations for variety trade-marks for different varieties of goods, which have already been registered by the Patent Office, as evidenced by the illustrative examples adduced in evidence by petitioner in this case. The issue here, therefore, is not only of interest to the particular litigants, but is also a matter of interest to the public in general, and to an entire industry (the plant industry).

## CONCLUSION.

It is respectfully prayed that the petition for certiorari be granted.

Respectfully submitted,

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
*Attorneys for Petitioner.*

# INDEX


| | Page |
|---|---|
| Opinions below | 1 |
| Jurisdiction | 1 |
| Questions presented | 1 |
| Statute involved | 2 |
| Statement | 2 |
| Argument | 2 |
| Conclusion | 5 |
| | 10 |


## CITATIONS

Cases:


| | |
|---|---|
| *A. B. Humphrey Co.* v. *Arkelian*, 34 F. (2d) 749 | 6 |
| *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538 | 5 |
| *Baldwin Co.* v. *Robertson*, 265 U. S. 168 | 4 |
| *Bayer Co.* v. *United Drug Co.*, 272 Fed. 505 | 6, 9 |
| *Canal Company* v. *Clark*, 13 Wall. 311 | 6 |
| *Century Distilling Co.* v. *Continental Distilling Co.*, 106 F. (2d) 486, cert den., 309 U. S. 662 | 8 |
| *Du Pont Cellophane Co. Inc.* v. *Waxed Products Co.*, 85 F. (2d) 75, cert. den., 299 U. S. 601 | 6 |
| *Elgin National Watch Co.* v. *Illinois Watch Co.*, 179 U. S. 665 | 6 |
| *Hoyt* v. *J. T. Lovett Co.*, 71 Fed. 173 | 10 |
| *Hygienic Products Co.* v. *Coe*, 85 F. (2d) 264 | 4 |
| *In re Canada Dry Ginger Ale*, 86 F. (2d) 830 | 9 |
| *In re Canada Dry Ginger Ale*, 87 F. (2d) 736 | 10 |
| *In re Meyer Bros. Coffee & Spice Co.*, 32 App. D. C. 277 | 9 |
| *In re Midy Laboratories*, 104 F. (2d) 617 | 10 |
| *In re Pierce Arrow Motor Car Co.*, 55 F. (2d) 434 | 9 |
| *In re Pitney-Bowes Postage Meter Co.*, 6 F. (2d) 717 | 9 |
| *In re Ric-Wil Co.*, 87 F. (2d) 516 | 8 |
| *Kellogg Company* v. *National Biscuit Co.*, 305 U. S. 111 | 6 |
| *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U. S. 537 | 6 |
| *Leclanche Battery Co.* v. *Western Electric Co.*, 23 Fed. 276 | 9 |
| *President Suspender Co.* v. *Macwilliam*, 238 Fed. 159, cert. den., 243 U. S. 636 | 9 |
| *Procter & Gamble Co.* v. *J. L. Prescott Co.*, 102 F. (2d) 773, cert. den., 308 U. S. 557 | 4 |

Cases—Continued. Page

*Sharp* v. *Coe*, 125 F. (2d) 185 ..... 8

*Speaker* v. *Shaler Co.*, 87 F. (2d) 985, cert. den., 301 U. S. 695 ..... 6

*Tomlinson of High Point* v. *Coe*, 123 F. (2d) 65 ..... 4

Statutes:

Revised Statutes, Sec. 4915 ..... 4

4917 ..... 5

Trade Mark Act of February 20, 1905 ..... 2, 3, 4, 6

# In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 763

DIXIE ROSE NURSERY, PETITIONER

*v.*

CONWAY P. COE, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA*

## BRIEF FOR THE RESPONDENT IN OPPOSITION

### OPINIONS BELOW

The district court delivered no opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 105–106)[1] is reported in 131 F. (2d) 446.

### JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered

[1] Printing of the record in this case has been dispensed with upon petitioner's motion. The record citations therefore refer to the typewritten transcript of the record filed with this Court.

November 16, 1942 (R. 107). A petition for rehearing was denied December 23, 1942 (R. 108). The petition for a writ of certiorari was filed February 25, 1943. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

### QUESTIONS PRESENTED

Whether, in the circumstances of this case, the Commissioner of Patents improperly refused to issue a certificate of registration of a trade-mark for rose plants, scions, and cuttings, consisting of the words "Texas Centennial" imposed upon a crude map outline base approximating the outline of the State of Texas.

### STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 726; 15 U. S. C. § 85) provides in part:

> * * * *Provided,* That no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, * * * or merely a geographical name or term, shall be registered under the terms of this Act: * * *

### STATEMENT

Petitioner owns Plant Letters Patent No. 162, dated January 21, 1936, covering a certain variety of rose plant listed in petitioner's catalogue

by the name "Texas Centennial" (R. 45, 47). This variety of rose is known throughout the trade, and purchasers call for it and for no other variety by that name (R. 45, 46). The rose is apparently grown and marketed only by petitioner and its licensees (R. 45), and although some licensees have agreed to tell purchasers of petitioner's connection with the rose, one may in fact buy "Texas Centennial" roses without learning that the original rose stock came from petitioner's nursery (R. 51, 74).

On April 24, 1936, petitioner filed in the United States Patent Office a formal application for the registration of its trade mark for rose plants, scions, and cuttings, under the provisions of the Trade Mark Act of February 20, 1905, c. 592, 33 Stat. 724, as amended (15 U. S. C. § 81). The mark consisted of the words "Texas Centennial" imposed upon a crude map outline base approximating the outline of the State of Texas, and the application alleged commencement of the use of the mark in interstate commerce on November 1, 1935. After full consideration, the Commissioner of Patents rejected the application on the grounds that "Texas Centennial" was the name of the variety of rose involved and thus "descriptive" of the plant, and that the name and map of Texas were "geographical," within the meaning of the

proviso in Section 5 of the Act. (*Supra,* p. 2 Pet. Ex. 1; Resp. Ex. 1; 45 USPQ 673; 46 USPQ 525.)

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63),[2] to direct the respondent, the Commissioner of Patents, to issue to petitioner a certificate of registration of its trade-mark, which the complaint alleged respondent had unjustly refused (R. 1–4). After a trial, the district court dismissed the complaint (R. 9), finding as facts that "Texas Centennial" was the variety name descriptive of the rose cov-

[2] This section, authorizing proceedings in the Federal district courts to review a refusal by the United States Patent Office to issue a patent on application, has been held also to be applicable to refusal by the Patent Office of an application for trade-mark registration. *Hygienic Products Co.* v. *Coe*, 85 F. (2d) 264, 266 (App. D. C.); *Tomlinson of High Point* v. *Coe*, 123 F. (2d) 65 (App. D. C.); see *Baldwin Co.* v. *Robertson*, 265 U. S. 168, 179–181. This remedy is apparently the result of Section 9 of the Trade Mark Act (15 U. S. C. § 89), which authorizes applicants for registration of a trade-mark to appeal from an adverse decision of the Commissioner of Patents to the United States Court of Customs and Patent Appeals, and which made applicable to trade-mark cases the conditions, rules of practice and procedure governing appeals to that Court in patent cases. Section 9 has been read to manifest an intention to make available in respect to trade-marks every remedy afforded in patent proceedings. *Procter & Gamble Co.* v. *J. L. Prescott Co.*, 102 F. (2d) 773, 782, *et seq.* (C. C. A. 3), certiorari denied, 308 U. S. 557.

ered by Plant Patent No. 162 and had not been applied to any other plant (R. 7), and that the licensees of petitioner in selling roses of the "Texas Centennial" variety were not required to indicate that petitioner supplied the original plant (R. 7). The court then concluded that "Texas Centennial" was not registrable under the Trade-Mark Act of 1905 because it was descriptive of the roses to which it applied, and that the word "Texas" and the outline map of the State of Texas were not entitled to registration because merely geographical (R. 8).[3] The court below affirmed the judgment of the district court (R. 107), holding that since the Patent Office and the district court might properly have concluded that the words "Texas Centennial" described to the public a rose of a particular sort and not a rose from a particular nursery, registration of the trade-mark was properly denied even though, by virtue of its patent, petitioner and its licensees were the only ones who for the moment produced the rose (R. 105, 106).

## ARGUMENT

Under the common law, the function of a trade-mark was to indicate the source of the particular product to which the mark was applied (*Elgin*

[3] The district court also held that refusal to register "Texas" and the state map was justified because of petitioner's failure to disclaim them under Section 4917 of the Revised Statutes (35 U. S. C. § 65); see *Beckwith* v. *Commissioner of Patents*, 252 U. S. 538, 545.

*National Watch Co.* v. *Illinois Watch Co.,* 179 U. S. 665, 673); consequently, words which were merely descriptive or geographical were not proper trade-marks. *Canal Company* v. *Clark,* 13 Wall. 311, 323 ("Lackawanna" coal); *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.,* 138 U. S. 537, 546 ("LL" for sheetings). This principle was restated in Section 5 of the Trade Mark Act of 1905, prohibiting the registration of words or devices that are merely descriptive of the goods with which they are used, or are merely geographical (*supra,* p. 2). The decisions construing this section clearly establish that the name of the product involved is a "descriptive" word and hence not registrable under the 1905 Act. *Kellogg Company* v. *National Biscuit Co.,* 305 U. S. 111, 116 ("Shredded Wheat"); *A. B. Humphrey Co.* v. *Arkelian,* 34 F. (2d) 749 (C. C. A. 9) ("Lady Finger Grapes"). While the name of a particular article may acquire the secondary meaning of the source of the article and thereby become a proper trade-mark (*cf. Speaker* v. *Shaler Co.,* 87 F. (2d) 985 (C. C. A. 7), certiorari denied, 301 U. S. 695 ("Hot Patch" as applied to rubber vulcanization)), the test to be applied in determining the term's eligibility for registration as a trade-mark is its meaning to the buying public. *Du Pont Cellophane Co.* v. *Waxed Products Co.,* 85 F. (2d) 75, 77 (C. C. A. 2), certiorari denied, 299 U. S. 601; *Bayer Co.* v. *United Drug Co.,* 272 Fed. 505, 509 (S. D. N. Y.). These well es-

tablished principles of trade-mark law were correctly applied by the Patent Office and the court below.

1. The district court found that the words "Texas Centennial" meant to the purchasers of roses the name of a particular variety of rose and not the source of the variety. Consequently, it concluded that the proposed trade-mark was descriptive and not entitled to registration. Contrary to petitioner's contention (Pet. 12, 24–26), this finding is adequately supported by the evidence. The American Rose Annual of 1936 lists "Texas Centennial" as a variety name of the rose in question (R. 84, Resp. Ex. 2) and similar listings are given in issues of the publication "Success with Roses" (R. 84, Resp. Exs. 3, 4). Indeed, one of petitioner's own witnesses, a member of his firm, unequivocally testified that "Texas Centennial" was the name of a particular variety of rose and had never been applied to any other (R. 41), and that the company's intention in adopting that name was to identify the plant therewith (R. 44).

The findings below that "Texas Centennial" does not describe the source of the rose is likewise supported by the evidence. One of petitioner's witnesses, the vice president of a licensee company, testified that his company was not required to tell its customers for "Texas Centennial" roses that the plant originated with the Dixie Rose Nursery, and that in some cases they did not so

inform them (R. 74). And a member of petitioner's firm testified that "Texas Centennial" roses could be purchased from licensees without the purchaser being informed that they came from petitioner's nursery (R. 50).

Petitioner's contention that the real name of the rose is "Red Hoover" and not "Texas Centennial" (Pet. 12) is without substance, for one of its witnesses testified that a "Red Hoover" rose "really is" a "Texas Centennial" (R. 46), and petitioner's own catalogue stated that the rose "Texas Centennial" was "a sport of the noted rose, President Herbert Hoover" (Pet. Ex. 9).

Petitioner has obviously failed to sustain his burden of showing by clear and convincing evidence that the decision of the Commissioner of Patents denying registration was erroneous. *Century Distilling Co.* v. *Continental Distilling Co.*, 106 F. (2d) 486 (C. C. A. 3), certiorari denied, 309 U. S. 662. And since the findings of the district court are supported by the evidence, their affirmance below was proper. Cf. *Sharp* v. *Coe*, 125 F. (2d) 185, 189 (App. D. C.) (patent registration). That the Patent Office may have registered other trade-marks which are claimed to be more descriptive than petitioner's (Pet. 28–32) is irrelevant. The issue presented is the correctness of the refusal to register in the instant case; administrative errors committed in other cases cannot change the law. *In re Ric-Wil Co.*, 87 F. (2d) 516, 517 (C. C. P. A.).

2. No importance attaches to the fact that the product for which the trade-mark was rejected was patented (Pet. 12, 37). Nothing in the Trade Mark Act of 1905 or in the judicial interpretation thereof indicates any intention to exempt a patent owner from any of its requirements; and the privilege of registering a patented article is the same as if the article were not patented. See *President Suspender Co.* v. *Macwilliam,* 238 Fed. 159, 163 (C. C. A. 2), certiorari denied, 243 U. S. 636; *Bayer Co.* v. *United Drug Co.,* 272 Fed. 505, 509 (S. D. N. Y.). Petitioner's rose is not to be denied trade-mark registration merely because the plant is covered by a patent, but it is not entitled to a trade-mark that is merely descriptive. *In re Pitney-Bowes Postage Meter Co.,* 6 F. (2d) 717, 718 (App. D. C.); see *Leclanche Battery Co.* v. *Western Electric Co.,* 23 Fed. 276, 277 (C. C. S. D. N. Y.).

3. There is no merit in petitioner's contention (Pet. 21–23) that its composite trade-mark taken as a whole is registrable under Section 5 of the Trade Mark Act of 1905. While a composite mark should be considered as a whole in determining its registerability (*In re Pierce Arrow Motor Car Co.,* 55 F. (2d) 434, 436 (C. C. P. A.)), a registrable mark cannot be formed merely by combining two nonregistrable features (*In re Meyer Bros. Coffee & Spice Co.,* 32 App. D. C. 277, 278). A mere geographical figure may not be registered as a trade-mark (*In re Canada*

*Dry Ginger Ale,* 86 F. (2d) 830 (C. C. P. A.) (map of Canada); see *Hoyt* v. *J. T. Lovett Co.,* 71 Fed. 173 (C. C. A. 3)), and, as already shown, neither may descriptive words alone. Petitioner's combination of descriptive words and geographical figure in no way changes the significance of either component; consequently the mark considered as a whole is not registrable under the statute. *In re Canada Dry Ginger Ale,* 87 F. (2d) 736, 737 (C. C. P. A.) ("Canada Dry" superimposed on map of Canada); *In re Midy Laboratories,* 104 F. (2d) 617, 618 (C. C. P. A.).[4]

CONCLUSION

The decision below is correct. There is no conflict of decisions and no question of general importance is presented. It is respectfully submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,
*Solicitor General.*
FRANCIS M. SHEA,
*Assistant Attorney General.*
DAVID L. KREEGER,
*Special Assistant to the Attorney General.*
ARMAND B. DU BOIS,
*Attorney.*

MARCH 1943.

[4] Since petitioner's composite mark is clearly nonregistrable, it is unnecessary to discuss its contention that where a trade-mark as a whole is not merely descriptive or geographical, disclaimer of the descriptive or geographical features is not a prerequisite to registration (Pet. 12, 34–35).

U. S. GOVERNMENT PRINTING OFFICE: 1943

[redacted]



## CONTENTS.


Page

Reply Brief for Petitioner ..... 1

Conclusion ..... 15


## CASES CITED.


A. B. Humphrey Co. v. Arkelian, 34 F. (2d) 749..... 9

Bayer Co. v. United Drug Co., 272 Fed. 505, 509..... 10

Dupont Cellophane Co., Inc. v. Waxed Products Co., Inc., 85 F. (2d) 75, 80, cert. den. 304 U. S. 538.... 5

General Talking Pictures Corp. v. Western Electric Co., et al., 304 U. S. 175, 186 ..... 6

Hamilton-Brown Shoe Co. v. Wolf Bros. & Co., 240 U. S. 251 ..... 10

Hoyt v. J. T. Lovett Co., 71 Fed. 173 ..... 9

In Re Canada Dry Ginger Ale, 86 F. (2d) 830..... 13

In Re Canada Dry Ginger Ale, 87 F. (2d) 736.....13, 14

In Re Canada Dry Ginger Ale, 87 F. (2d) 737.....13, 14

In Re Meyer Bros. Coffee & Spice Co., 32 App. D. C. 277, 278 ..... 13

In Re Midy Laboratories, 104 F. (2d) 617, 618..... 14

Keebler Weyl Baking Co. v. J. S. Ivins' Son, Inc., 7 F. Supp. 211, 214 ..... 12

Kellogg Company v. National Biscuit Co., 305 U. S. 111, 116 ..... 8

Menendez v. Holt, 128 U. S. 514 ..... 12

Mishawaka Rubber and Woolen Manufacturing Co. v. S. S. Kresge Co., 316 U. S. 203, 205 ..... 1

President Suspender Co. v. Macwilliam, 238 Fed. 159, cert. den. 243 U. S. 636 ..... 14

Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 186 .....5, 15

Speaker v. Shaler Co., 87 F. (2d) 985 ..... 8


## OTHER AUTHORITIES CITED.


Derenberg, Trade-Mark Protection and Unfair Trading, 1936, Chap. 2, Sec. 3, pp. 34-35 .....11, 12

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1942

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No. 763

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DIXIE ROSE NURSERY, *Petitioner,*

v.

CONWAY P. COE, Commissioner of Patents, *Respondent.*

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## REPLY BRIEF FOR PETITIONER.

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In the brief for respondent, counsel have appropriately and succinctly stated, at pages 5 and 6, the basic principle of the common law of trade-marks, which was that the function of a trade-mark is to indicate the *source* of the particular product to which the mark is applied.

The basis of this principle is exceedingly well stated by Mr. Justice Frankfurter in *Mishawaka Rubber and Woolen Manufacturing Co.* v. *S. S. Kresge Co.*, 316 U. S. 203, at page 205, as follows:

> "The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select

> what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain redress."

It is admitted by petitioner that such was the basic principle which was carried forward into the Trade-Mark Act of 1905 which expressly prohibits the registration of marks that are *merely* descriptive of the goods with which they are used, or are *merely* geographical.

The difficulty here arises from the failure of the Courts below to correctly apply this principle to the facts presented in this case, and the misapplication of the construing authorities both by the Court below and by counsel for respondent. In other words, the Court of Appeals below has announced a totally new principle or theory which ignores or at least emasculates the basic principle above referred to. This is fully evident from the language of the Court in its decision at pages 105 and 106 of the transcript of the record, reading as follows:

> "If a man should invent a combination automobile and airplane, and call it an ambi, the name would at first be arbitrary and not descriptive. But if the name were applied, for a considerable period, to all such combinations and to nothing else, the name would come to identify or describe the thing, as the word 'cellophane' has come to describe a thing. * * * The Patent Office and the District Court might properly conclude that the words 'Texas Centennial', though originally arbitrary, have come to describe to the public a rose of a particular sort, not a rose from a particular nursery."

This theory of the Court below has no foundation in fact or in the language of the Trade-Mark Act of 1905 which defines the right of and inhibitions against *registration* of trade-marks. Moreover, as applied to the facts in this case, the theory of the Court below has the effect of prohibiting registration of petitioner's trade-mark substantially *immediately* after adoption of the mark (having in view that petitioner's application for registration was filed less than six months after adoption of the mark), and notwithstanding the admission by the Court that the Patent Office and the District Court might properly have held that petitioner's mark was *originally arbitrary;* also, notwithstanding the absence of any 'considerable period' of use at the time of filing application for registration, upon which the Court premised its theory of acquisition of descriptive significance of marks used upon nothing else than the newly invented thing for a considerable period. Even adding to this the few years occupied by the proceedings in the Patent Office and in the Courts below, up to the date of the decision of the Court of Appeals, is not a *considerable period* such as to imply the acquisition of descriptive significance of petitioner's trade-mark as in the Cellophane case. Mere lapse of time was not the controlling factor in the Cellophane case where the issue was trade-mark infringement *after* expiration of the patent on the goods. Petitioner's patent here has not yet expired.

Counsel for respondent totally ignore the principles announced by the Court below in reaching its decision, which principles are *new* and which must necessarily constitute the issues before this Court. While it may be true that the primary issue is whether the Commissioner of Patents improperly refused to issue a certificate of registration for petitioner's mark, there are other issues involved necessarily by virtue of the new reasons and theories, and misapplication of authorities, relied on by the Court below in reaching its conclusion on the primary issue, all of which counsel for respondent pass over in their brief, which purports to

justify by another line of argument and further misapplication of authorities and principles of law, independently of the opinion below, the erroneous conclusion on the main issue.

The authorities relied upon by respondent are easily distinguished from the present case and do not support respondent's contention that registration of petitioner's trade-mark was properly refused. Rather, many of these same authorities announce principles which support petitioner's right to registration of its mark.

No parallel case has been cited in respondent's brief, and as indicated in the main brief of petitioner, counsel for petitioner have likewise found none, thereby pointing to the novelty of the issue in this case so far as it relates to the general right of registration under the Act of 1905, in a proceeding before the Patent Office. Most of the authorities relied on by respondent, and particularly the Singer and Cellophane cases relied on by the Court of Appeals below, spring from a construction of the Act in suits for infringement *after* registration of the trade-mark, and deal with the general proposition of loss of exclusive right to the registered trade-mark either as a result of expiration of the patent on the goods to which the trade-mark was applied, or where the registration of the mark was improperly granted by reason of the lack of the registrant's exclusive right to or ownership of the mark at the time the registration was applied for. These are totally different circumstances from those involved in this case. *Even in the case of marks which are purely and inherently descriptive in their ordinary and fundamental sense, and are used on patented goods, the Courts have not held that the registered marks were invalid during the life of the patents on the goods,* but rather it is the exclusive right to the registered mark which the Courts have held was lost on expiration of the patents because of the loss of the monopoly on the goods. Even then, competitors of the original proprietor are required to clearly distinguish between their goods and those of the original pro-

prietor so as to prevent the palming off of the competitors' goods for those of the original proprietor.

Accordingly, the Courts still give full recognition to the right of protection of the proprietor's original good-will against unfair competition notwithstanding a declaration of loss of the trade-mark rights upon expiration of the patent monopoly on the goods. This is the doctrine of the Singer and Cellophane cases which petitioner distinguishes from this case in its main brief, and which respondent does not dispute in his brief.

In spite of the fact that the Court of Appeals below relied heavily and primarily on the Singer and Cellophane cases, both of which involve as the basic issue the loss of trade-mark monopoly on patented goods *after* expiration of the patent, counsel for respondent state at page 9 of respondent's brief, paragraph numbered "2":

> "No importance attaches to the fact that the product for which the trade-mark was rejected was patented."

How could this statement be true in the face of the language quoted at page 2 herein from the decision below, and which is further expressly predicated upon the very existence of petitioner's patent as evidenced by the following words found near the end of the decision:

> "To allow registration of the name 'Texas Centennial' would give appellant an unfair advantage, despite the fact that only appellant and its licensees now produce Texas Centennials. *It would tend to prolong appellant's monopoly, beyond the life of appellant's patent, by making it difficult for a newcomer to break into the field.* We cannot read such an intent into the Trade-Mark Act." (Italics ours.)

The Trade-Mark Examiner's original ruling in the Patent Office, that petitioner's trade-mark was not registrable because the plants put out under the said trade-mark were patented, was expressly *over-ruled* by the Commissioner below (Pl. Ex. #1, p. 63). This ruling was at least affirmed

by the judgment of the District Court, and then the refusal on the above ground was restored or re-established by the Court of Appeals below, the decision of which Court is sought to be reviewed on this point, among others, by the present petition because improperly grounded in law. It may be appropriate to remark, in connection with the above matter, that respondent apparently recognizes by its concession in the first paragraph at page 9 of its brief that the decision of the Court of Appeals below went too far in the above pronouncement *affecting trade-marks for patented products*, and is now seeking to eliminate from discussion the issue raised on this point by petitioner herein, as well as seeking to set aside the effect of the last decision below. The respondent recognized the invalidity of the reasoning of the court below and its fatal effect, if sound, upon thousands of registrations of trade-marks now in existence. The Commissioner of Patents well knows that he and his predecessors have registered such thousands of trade-marks for patented products since the passage of the 1905 Act, and the decision of the court below so clearly disturbs the valid status of such registrations as to create great confusion and a status of questionable validity of such registrations in respect to the owners thereof.

Moreover, this Court has appropriately recognized by the language found in the dissenting opinion of Mr. Justice Black, in *General Talking Pictures Corp.* v. *Western Electric Co., et al.*, 304 U. S. 175, at page 186:

> "At this time a great portion of the common articles of commerce and trade is patented. * * * Patented articles are everywhere."

Petitioner asserts that it was not the intent of the Act to inhibit registration of marks of the character here involved when used upon patented goods, and this is amply borne out by the actual grant of thousands of registrations for marks of a similar character which are obviously used in commerce upon patented goods.

Yet the Courts below in the instant case have unquestionably applied a different rule to petitioner's patented articles (roses, scions and cuttings) in determining petitioner's right of registration of its trade-mark for such articles, than has been customarily applied to the determination of registrability of trade-marks for other commonly patented articles of commerce ever since the enactment of the Act of 1905, as evidenced by the thousands of registrations which have been granted under this Act, and illustrated by the selected registrations which are exhibits in this case.

Both the Patent Office, and now counsel for respondent here, have attempted to ignore or excuse these prior illustrative registrations as being irrelevant, or as being administrative errors, (page 8, of respondent's brief) but we respectfully submit that these prior registrations are not only perfectly relevant, but also conclusively show the correct meaning and interpretation of the statute in question as it has existed for nearly forty years. Thus, the grant of thousands of registrations for trade-marks which are fully comparable to the mark here in issue, and indeed, the registration of the very same mark for a variety of wine (Reg. #340,379, Pl. Ex. #12), is a far safer guide to the right of registration of petitioner's mark than the labored reasonings and theories relied on by respondent and the Courts below.

Petitioner never has, and does not now contend that the other marks that have been registered by the Patent Office are *more descriptive* than petitioner's mark, and therefore denies the statement found at page 8 of respondent's brief and purporting to be attributed to the Petition at pages 28-32. Petitioner certainly does not contend that the registered marks there referred to are descriptive, but logically and properly relies upon the grant of those registrations as illustrative of thousands from which the particular registrations were selected at random, to show that the practice of registering marks under circumstances similar to those involved here, has long been well settled and that even after the decision below, and up to the date of filing of the peti-

tion here, the Patent Office is not following the theory or principles of the decision below. *Where could there be a clearer case of discrimination against petitioner in respect to the right of registration here sought to be established by this Court!*

The cases construing Section 5 of the Act of 1905 as regards the unregistrability of merely descriptive names of products are legion. They hinge largely on the question of whether or not the names are generic and the only names by which the products are known, or are so aptly descriptive of a characteristic or quality of the product as to be inherently descriptive of the product. For example, in the "Shredded Wheat" case (*Kellogg Company* v. *National Biscuit Co.*, 305 U. S. 111, 116), referred to at page 6 of respondent's brief, this Court said:

> "The plaintiff has no exclusive right to the use of the term 'Shredded Wheat' as a trade-name. For that is the generic term of the article, which describes it with a fair degree of accuracy; and is the term by which the biscuit in pillow-shaped form is generally known by the public. Since the term is generic, the original maker of the product acquired no exclusive right to use it."

Moreover, the Court further observed in that case the fact that the basic patent for the product and for the process of making it, and in many other patents for special machinery to be used in making the article, the patents repeatedly used the term "shredded" as descriptive of the product. In these respects, that case is parallel to the Cellophane case referred to at pages 5, 9, 10, 16, 20 and 32 of the petition and petitioner's supporting brief. Neither of these cases, therefore, constitutes a controlling authority as to the particular issues here, for the reasons given above and in petitioner's main brief.

The case of *Speaker* v. *Shaler Co.*, 87 F. (2d) 985, referred to at page 6 of respondent's brief, falls in the same category as the "Shredded Wheat" case. There, the words "Hot Patch" are aptly descriptive of the goods and could

not possibly have any other meaning to the public, and the goods could not be obtained by the public by any other name. This is quite different from the facts here.

The Lady Finger Grapes case (*A. B. Humphrey Co.* v. *Arkelian*, 34 F. (2d) 749), cited at page 6 of respondent's brief, is also distinguished from the instant case for the important reason that the registrant was not the originator of the mark "Lady Finger" and was not entitled to the exclusive use of the mark when the registration was applied for. On the contrary, the proofs showed that the name "Lady Finger" was adopted because of the resemblance of the shape of the grapes to the shape of ladies' fingers, and therefore aptly descriptive of a characteristic or attribute of the article on which the mark was used; and more importantly, the name was known as the name of the goods many years prior to adoption and use of the name by the registrant. Therefore, the mark "Lady Finger" was not even a good mark at common law. Moreover, the registrant was not the originator of the *product*, as in the case here, so there was no patent on the product to establish a control of the goods by a single source. Thus, the Lady Finger Grape case is similar to the case of *Hoyt* v. *J. T. Lovett Co.*, 71 Fed. 173, cited at page 10 of respondent's brief, and which involved the use of the obviously geographical name "Green Mountain" on grapes. Since Hoyt was not the first user of the name "Green Mountain" and the name was originated by another to designate the place of origin of the original vines which were discovered growing wild on the side of the Green Mountains in Vermont, Hoyt clearly had no exclusive right to such a geographical name. Incidentally, it may be pointed out here that the Lovett case was decided before the passage of the Act of 1905, and before the amendment to the patent statutes which provides for the patenting of plants.

As contrasted with the facts of both the Shredded Wheat case and the Lady Finger Grape case, petitioner's mark here is neither generic nor aptly descriptive of petitioner's

goods as will be clearly apparent from the application of the test of the mark as applied by this Court in *Hamilton-Brown Shoe Co.* v. *Wolf Bros. & Co.*, 240 U. S. 251, cited and discussed at length in petitioner's main brief at pages 22 and 23. Moreover, the evidence in this case conclusively establishes that the generic name of petitioner's goods is "Red Hoover" and was so known by the public and the trade both before and since the adoption of the "Texas Centennial" mark here in issue.

This factor is significant, as was observed by the Court in *Bayer Co.* v. *United Drug Co.*, 272 Fed. 505, 509, cited at page 6 of respondent's brief. Judge Learned Hand there said:

> "The validity of a trade-mark does not, indeed, rigidly depend upon its meaning only the differential between a genus, defined by the kind of goods, and a species, defined by that kind when emanating from the owner. Guastavino v. Comerma, (C. C.) 180 Fed. 920. When it means the owner as well as the kind, it will be entitled to a qualified protection; when, as here among the trade, there is another current word, it may be entitled to absolute protection, patent or not. For a patent gives the public no greater rights than it has without patent."

Since both the trade and the public, in the case of petitioner's mark here, definitely have another current name "Red Hoover", well known to them and extensively advertised by petitioner as the generic name of its goods, petitioner is entitled to absolute protection of its "Texas Centennial" mark, patent or no patent, and the mark clearly qualifies as a registrable mark under the Act.

With regard to respondent's views as to the evidence in this case, discussed under paragraph numbered "1" at pages 7 and 8 of respondent's brief, these views in large measure distort the testimony of petitioner's witnesses as to the facts, and consequently are the personal views of counsel for respondent as to the facts. It is well recognized that on cross-examination, a witness sometimes becomes

confused and may give answers which may be subject to a meaning different from that intended, but which answers are wholly satisfactory to the cross-examiner. Petitioner submits that the findings below are not supported by the evidence when considered in its entirety.

For example, counsel for respondent state at page 7 of respondent's brief, that "one of petitioner's own witnesses, a member of his firm, unequivocally testified that 'Texas Centennial' was the name of a particular variety of rose and had never been applied to any other (R. 41), and that the company's intention in adopting that name was to identify the plant therewith (R. 44)." However, it is clear from the testimony of the witness Watkins, as a whole, that what he meant was that the name "Texas Centennial" was a variety name in the same sense that every trade-mark name, like thousands that have been registered, becomes the variety name of the particular goods on which the mark is used, and that the company's intention in adopting the name was to identify the plants with the company, thereby denoting origin in the petitioner company like any other trade-mark (Tr. 43, 48, 49). Moreover, this is fully corroborated by the testimony of the witness Stark (Tr. 68).

The fact that petitioner and its licensees are not required to tell their customers that the plants originated with the Dixie Rose Nursery, as stressed by respondent at pages 7 and 8 of respondent's brief, is not controlling. As appropriately pointed out by Derenberg in "Trade-Mark Protection and Unfair Trading" (Ed. 1936, Chapter 2, Section 3, pp. 34-35):

> "It is only since the end of the last century, then, that with the gradual recognition of the word trade-mark, the edge of the traditional doctrine of indication of origin and ownership was blunted. From that time the concept of the trade-mark was no longer inextricably bound up with the name of the manufacturer and the place of manufacture. Now attention was focused upon the 'reputation of the goods.' The courts began to realize that it was the mark itself which caught the pub-

lic's eye rather than its manufacturer or place of manufacture.

> 'We may safely take it for granted that not one of a thousand knowing of or desiring to purchase "Baker's Cocoa" know of Walter Baker & Co., Ltd.'
>
> Examples are legion which prove that nine out of ten buyers did not know the producer of the article they usually bought."

This position is particularly applicable to the extensive licensing practice of the present day, employed by most patent owners, as well as by petitioner here, to extend their market by the grant of licenses to produce and sell the patented goods. The grant of such licenses does not affect the trade-mark of the licensor. This is fully borne out by the decision in *Keebler Weyl Baking Co.* v. *J. S. Ivins' Son, Inc.*, 7 F. Supp. 211, 214, in which the Court said:

> "The use of a trade-mark does not any longer necessarily import that the articles on which it is used are manufactured by the user but it may be enough that they are manufactured for him, that he controls their production or even that they pass through his hands in the course of trade and that he gives to them the benefit of his reputation and name or business style. * * * An article need not be actually manufactured by the owner of the trade-mark, it being enough that it is manufactured under his supervision and according to his directions thus securing both the right of the owner and the right of the public. * * *"

In this connection, petitioner asserts that its "Texas Centennial" trade-mark is equivalent to its signature, just as this Court held in *Menendez* v. *Holt*, 128 U. S. 514, that the mark "La Favorita" was equivalent to the signature of Holt & Co., even though their name did not appear upon the goods sold by their agents or licensees.

In addition, the evidence in this case amply proves that the roses sold to the trade by petitioner and its licensees bear the trade-mark tag of petitioner, and petitioner has

full control over its licensees in respect to the growing and marking of the plants by the latter (Tr. 50, 52, 53).

Counsel for respondent likewise distort the evidence as to the descriptive or non-descriptive significance of petitioner's mark. Respondent's only basis for the view that the mark is descriptive is the mere listing of the mark in petitioner's catalogues and in other publications. Such publications are not self-proving as regards evidence of descriptiveness and any descriptive significance attached to listings of this character is purely and simply the personal opinion of counsel for respondent. If such a test of descriptiveness as is here relied on by respondent, were applied to all trade-marks generally, every trade-mark would be descriptive and no marks would be registrable.

Respondent carefully evades the disclaimer issue raised under paragraph numbered "2" (page 13) in the petition, under The Questions Presented, and argued in petitioner's main brief under Point VI (pages 34, 35). The decisions cited in paragraph "3," at pages 9 and 10 of respondent's brief are not in point. Petitioner's composite trade-mark is not composed by merely combining two non-registrable descriptive features, or two non-registrable geographical features, or a non-registrable descriptive feature and a non-registrable geographical feature. In the case of *In re Meyer Bros. Coffee & Spice Co.*, 32 App. D. C. 277, 278, the mark "America's Strength" is composed of an obviously geographical word and an obviously descriptive word aptly describing a characteristic or quality of coffee, leaving nothing else on which to predicate an arbitrary, non-descriptive meaning of the mark as a whole. Likewise, the map of Canada *alone*, which was the mark involved in the case of *In re Canada Dry Ginger Ale*, 86 F. (2d) 830, could be nothing else than geographical, and therefore unregistrable. In the later decisions involving the *composite* mark "Canada Dry" and map of Canada (*In re Canada Dry Ginger Ale*, 87 F. (2d) 736 and 87 F. (2d) 737), the cases turned on a totally different ground, namely, that the words "Canada Dry" had already been registered under the 1920

Amendment to the Act of 1905 (providing for the registration of descriptive marks), and by reason of the thus admitted descriptive significance of the words "Canada Dry", there was an estoppel against registration of the composite mark, because both the words and design were clearly within the inhibitions of the statute.

In the case of *In re Midy Laboratories,* 104 F. (2d) 617, 618, the mark sought to be registered was "Piperazine-Midy", and the applicant admitted that the word "Piperazine" was descriptive of the goods, and since "Midy" was obviously a surname, the composite mark was clearly unregistrable.

For the above reasons, these cases are all easily distinguished from the present case and constitute no authority against the question presented here. In the proceedings below, it has never been held that the words "Texas Centennial" together are geographical, but only the word "Texas" alone and the map. This distinguishes the present case from the "Elgin" and "Lackawanna" cases cited at page 6 of respondent's brief. Moreover, there is no evidence having the character of the positive proof required by the Court in *President Suspender Co.* v. *MacWilliam,* 238 Fed. 159, cert. den. 243 U. S. 636, pointing to a descriptive significance of the words "Texas Centennial" as applied to roses, scions and cuttings, to justify the holding that petitioner's mark is descriptive. As measured by the test used by this Court in the Hamilton-Brown Shoe case, supra, the only proper conclusion is that these words as a whole are not descriptive of petitioner's goods, and the assertions to the contrary by respondent are purely that presumption which has been condemned by the Courts.

It is further significant that respondent totally ignores the issue, as did the Court of Appeals below, raised in paragraph "5" (page 14) of the petition, under The Questions Presented. The very failure of counsel for respondent and the Courts below to apply their conclusions to all the facts established by the evidence, accounts, in part at least,

for the misapplications of the principles of law and misconstructions of the Trade-Mark Act of 1905, which are presented in the brief of respondent and in the decision below. In other words, respondent's brief is based entirely upon the position taken by the Patent Office rather than either the evidence or the new and theoretical principles applied by the Court below.

## CONCLUSION.

If the new principles and theories applied to this case by the Court of Appeals below, are to be taken as the true measure of the Trade-Mark Act of 1905, it is not seen how any trade-mark, used upon a single product emanating from a single source, in general, or upon plants in particular, may be registered under the Act, whether such goods are patented or not. Furthermore, in the case of patented goods, the trade-mark proprietor will be penalized for having obtained a patent, especially if he may not even register his trade-mark *during* the life of the patent, as has been held here by the Court below. Surely, this was not the legislative intent of the Act, as evidenced by the following words of this Court, found in the Singer Case relied on by the Court below:

> "To say that a person who has manufactured machines under a patented monopoly can acquire no good-will, by the excellence of his work, or the development of his business, *during the patent,* would be to seriously ignore rights of private property, and would be against public policy, since it would deprive the one enjoying the patent of all incentive to make a machine of a good quality, because at its termination all the reputation or good-will resulting from meritorious work would be subject to appropriation by every one. On the other hand, to compel the one who uses the name after the expiration of the patent, to indicate that the articles are made by himself, in no way impairs the right of use, but simply regulates and prevents wrong to individuals and injury to the public." (Italics ours.)

The above principle pronounced by this Court has been completely ignored or misapplied by the decision of the Court of Appeals below, and is directly contrary to the statement by the Court in its decision that "It is conceived to be unfair to require buyers who are indifferent to source, and want merely goods of certain characteristics, to name a particular source in order to name the desired characteristics." This Court did not conceive it to be unfair in the Singer case even though it was dealing with the effect of the trade-mark *after* expiration of the patent, as distinguished from the right of registration *before or during* the life of the patent, which is the issue here.

For the foregoing reasons, it will be fully apparent that this case presents a question of substance and general importance, involving a construction of a Federal statute. Unless the decision below is corrected and reversed by this Court, a grave hardship and injustice will be imposed upon petitioner and upon the entire plant industry, as well as upon all trade-mark owners at large.

Accordingly, it is further prayed that the petition for certiorari be granted.

Respectfully submitted,

HARRY C. ROBB,
JOHN F. ROBB,
HARRY C. ROBB, JR.,
*Attorneys for Petitioner.*